

REMARKS

Claims 1-24 are pending in the application. Applicant elects with traverse to prosecute claims 11-18 drawn to a method of making an offer as defined by the Examiner.

Claim 18 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it was not understood by the Examiner how "synchronizing" does anything to further limit the scope of the claim unless the desired result is specified. Applicant has amended claim 18 and requests that this rejection be withdrawn.

Claims 11-18 have been rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The Examiner asserts that claim 11 fails to positively recite any technology art, which to the exclusion of human intervention effects the method. Applicant has amended claims 11-18 to more clearly define the invention and requests that this rejection be withdrawn.

Claim 11 has been rejected under 35 U.S.C. §102(e) as being anticipated by Walker et al. (U.S. Pat. No. 6,119,099). MPEP §2131 provides that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. The identical invention must be shown in as complete detail as contained in the claim. The elements must be arranged as required by the claim.

Applicant has amended claim 11 to more clearly define the invention. In particular, claim 11 recites in part that the electronic solicit will be delivered "by transmitting the electronic solicit over a telecommunications medium if selected so that the consumer receives the electronic solicit remote from the service center". For example, an electronic solicit, such as an email, may be sent to a consumer's home PC or handheld device. Walker et al. discloses a method and system for processing supplementary product sales at a point-of-sale (POS) terminal. In this respect, all transactions between a consumer and the POS

terminal take place while the consumer is physically located at the same place as the POS terminal. Walker et al. does not disclose the use of a telecommunications medium for transmitting electronic solicits as claimed and therefore does not meet the requirements of an anticipation rejection. Thus, applicant respectfully submits that amended claim 11 and those claims depending there from are not anticipated by Walker et al.

Claims 11-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Walker et al. in view of Call (U.S. Pat. No. 6,154,738). Applicant respectfully traverses this rejection.

Initially, applicant contends that the Examiner has failed to establish a *prima facie* case of obviousness as detailed in MPEP §§2142 and 2143. As stated therein, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to someone of ordinary skill in the art, to modify the reference or combine reference teachings. There must be a reasonable expectation of success and the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Additionally, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.

Walker et al. discloses a POS terminal, such as a cash register located at a store visited by customers, that determines an "upsell" to offer a customer in exchange for the change due to the customer in connection with a purchase. An upsell "is a product (good or service) which is offered along with a purchase and

has a value equal to a predetermined upsell price" (col. 3, lines 23-25). Walker et al. emphasizes the burdens to customers of carrying and exchanging coins with a cashier and the costs incurred by businesses associated with exchanging coins with customers and managing coins as part of their day-to-day business management (column 1, lines 18-65). The problem being solved by Walker et al. is reducing or eliminating the need to exchange coins between a customer and a cashier at the POS terminal as well as allowing a store, such as a supermarket, to offer goods to a customer for inventory reduction. In this respect, the solution disclosed by Walker et al. is to offer an upsell along with a purchase that has a value equal to a predetermined upsell price.

Call discloses methods and apparatus for disseminating product information via the Internet using universal product codes. More particularly, the "preferred embodiment of the present invention employs an Internet resource, called a "product code translator," for storing cross-references between universal product codes identifying specific products and Internet addresses specifying the locations at which information about these products may be obtained. The cross-references specify the universal product codes assigned to the participating manufacturers, such as the U.P.C. and EAN codes widely used in retail stores for barcode scanning at checkout counters, and the Internet addresses where information can be obtained about the products designated by those codes." (col. 1, line 60 through col. 2, line 3). Call provides a solution to the problem of how to widely disseminate information. For example, column 10, lines 3-25 provides numerous examples of the type of information that a manufacturer may want to make available for potential buyers including "warranty and guarantee explanations". (col. 10, lines 23-24). However, there is not teaching or suggestion with respect to generating an offer for extended warranty services associated with one or more products purchased by a consumer as recited in amended claim 11.

The Examiner contends that the motivation to modify Walker et al. to include the communication options of Call would be to "satisfy the customer" and the motivation to further modify Walker et al. to include the unique identifier

"within the body of the email so as to embed a link within the email to the offer" would be to "ease the effort of the consumer in finding the solicit" (Page 5 of the Office Action). However, applicant respectfully submits that the basis for this contention is absent from both Walker et al and Call. One skilled in the art would find no such motivation because the customer's interaction with a seller occurs at the time and point-of-sale with respect to the transactions disclosed in Walker et al. This is a necessary component for solving the problems associated with exchanging coins during a sale or inventory reduction. The upsell must be offered at the time of the sale or the purpose of the solution will be defeated. In this respect, the solution disclosed in Walker et al. teaches away from applicant's invention for that same reason. The solution of Walker et al. teaches away because its objective is to offer an upsell along with a purchase so a customer may immediately accept or reject the upsell offer. Thus, one skilled in the art would not be motivated to modify Walker et al. as contended by the Examiner.

Additionally, the "unique identifier" examples broadly referenced by the Examiner in Walker et al. (col. 10, lines 10-67) may be used for several purposes related to tracking vouchers, coupons, game awards or customer information, for example. The unique identifiers may be indicia on printed matter or used for accessing specific information in a database. However, the fact that Walker et al. employs unique identifiers for these purposes does not support the contention that one skilled in the art would be motivated to include one in the body of an email and to further embed a link within the email to an offer. Again, the purpose of Walker et al. is to offer an upsell at the time and point-of-sale, which is the entire essence of the Walker et al. teachings. There is no teaching, suggestion or other motivation found in Walker et al. or Call to modify Walker et al. as suggested by the Examiner to arrive at the invention as a whole as recited in amended claims 11-18.

Applicant respectfully points out that col. 6, lines 13-15 of Call, identified by the Examiner, explain that data submitted to a registration handler may be accepted in several ways including an "incoming email message containing the necessary information, or receiving the needed information by telephone or

regular mail." (col. 6, lines 13-15). No mention or suggestion is made, as contended by the Examiner, that "Call does offer the customer the options of receiving notifications via e-mail, telephone or regular mail see col. 6 lines 13-15." (Page 4 of the Office Action). There is no teaching or suggestion to transmit outbound emails with an embedded link so that a consumer may access an extended warranty offer generated for that consumer in response to that consumer's purchase of a product or products as claimed in the present invention. Furthermore, the Examiner generally refers to col. 2 of Call disclosing "embedding in a message a HTTP request which is returned with a locator header containing a destination URL specifying the particular Internet address." (Page 4-5 of the Office Action). It would appear as though, and applicant assumes, the Examiner is referring to lines 35-44 of col. 2 and interpreting "message" to mean an email and using this as the basis for rejecting originally filed claim 16.

In this respect, applicant respectfully submits that the term "message" refers to "a request message containing at least a portion of the universal product code" that is generated when a web browser activates a link to product information contained in a web page (col. 2, lines 14-24) and not an email message as claimed in amended claim 16. Thus, applicant further submits that neither the cited disclosure of Call nor any other disclosure therein teaches, suggests or would otherwise motivate one skilled in the art to arrive at the invention as a whole claimed in amended claims 11-18.

Further, it is well settled that the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Neither Walker et al. or Call teach or suggest the requisite desirability. It is also well settled that the Examiner may not rely upon hindsight to arrive at the determination of obviousness. Instead, some objective teachings must be identified to combine or modify the relevant teachings of the prior art. Applicant respectfully submits that this burden has not been met. The Examiner does not identify objective teachings sufficient to motivate one skilled in the art to

modify Walker et al. in view of Call and cause that person to arrive at the invention as a whole as recited in amended claims 11-18.

As submitted above, the motivations contended by the Examiner are contradictory to the teachings of Walker et al. because the customers discussed therein need to be presented with an offer at the POS terminal not sometime thereafter. In this respect, the modification proposed by the Examiner would render the teachings of Walker et al. unsatisfactory for their intended purpose, which is to offer an upsell to a customer at the POS terminal so the customer has an opportunity to accept or reject the offer. Thus, applicant respectfully submits that the proposed modifications to Walker et al. are improper and cannot be the basis for rejecting any of the claims defining the instant invention.

In view of the above, applicant respectfully requests reconsideration of this application and submits that amended claims 11-18 are in condition for allowance. Notice to that effect is respectfully requested.

The Examiner is invited to call applicant's representative at the number below to discuss any aspects of this application to move it more expeditiously to allowance.

DATED this 30th day of July, 2004.

Respectfully submitted,



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